

Remarks

In the instant Office Action dated June 19, 2008, the following rejections are noted: claims 1-5 and 9-17 stand rejected under 35 U.S.C. § 103(a) over Sanford (US Patent No. 6,424,300) in view of Krasner (U.S. Patent No. 6,799,050); and claims 8 and 20 stand rejected under 35 U.S.C. § 103(a) over Sanford in view Krasner and further in view of the Schamberger (U.S. Patent Pub. 2003/0117331). Applicant appreciates the comment that claims 6-7 and 18-19 are objected to but would be allowable if rewritten in independent form.

In the following discussion, Applicant traverses each of the rejections and, as should be apparent, Applicant does not acquiesce to any objection, rejection or averment made in the Office Action. Before addressing these rejections, however, Applicant first addresses the Office Action's objection to the Specification, namely the Abstract.

Applicant has reviewed the Abstract and it appears to be in acceptable format. As shown in the USPTO published version, the Abstract includes only one paragraph. Unless there would be another issue to address, Applicant requests that the Office Action objection be withdrawn.

After examining the basis for rejecting claims 1-5 and 9-17, and the rejection of claims 8 and 20, under the § 103(a) rejection over Sanford in view of Krasner, Applicant traverses and submits that these rejections are improper for failure to present a *prima facie* case on both correspondence to the asserted teachings and an articulated nonconclusory basis for asserting that the skilled artisan would implement the combination. In connection with this rejection, Applicant submits that the Office Action satisfies neither requirement.

With respect to the requirement of correspondence to the asserted teachings, the Office Action acknowledges that Sanford does not teach the invention as a whole (e.g., with no teaching of at least the last three lines of claim 1 involving deactivation of the notch antenna), and a careful review of Krasner reveals that Krasner fails to teach or suggest use of notch antennas and fails even to use the word "notch". Rather, as pointed out elsewhere in the Office Action, Krasner teaches an antenna transmit/receive switching function, through various structural blocks as identified in Krasner's Figures 1-2. The Office Action has attempted to support the rejection by combining the Krasner switching function with the

overall teaching of Sanford and thereby construct functionality, which would seem to be similar to Applicant's invention. The Office Action, however, does not attempt to identify any specific structure as corresponding to the structure set forth in the rejected claims, and does not attempt to explain what hypothetical structure is being relied upon (for this combination of teachings).

Moreover, neither asserted reference teaches a structure for "de-activating the notch antenna when a PIFA is being used for transmitting signals". Accordingly, the rejections are untenable because no combination of teachings from these references can be used to reconstruct Applicant's claimed invention. The rejection is improper and must be withdrawn.

Applicant finds nothing in the Office Action that might serve as satisfying the requirement of articulating a nonconclusory basis that the skilled artisan would implement the combination. Indeed, the evidence shows that the skilled artisan would not be so motivated. M.P.E.P. 2143.01 states that "(i)f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)." The modification proposed by the Office Action would incorporate significant circuitry from Krasner's Figures 1 and 2 and thereby essentially eviscerate the teachings of the Sanford reference, which stresses the importance of miniaturizing the PCB (*see, e.g.*, Summary section generally, Col. 4:18- and Col. 4:58-, and in particular the discussion of the relied-upon embodiments shown for Figures 6 and 7 (Krasner fails to address miniaturization and/or structure for controlling such miniaturized circuitry). The proposed modification would change the Sanford embodiment by replacing the PCB implementation with a system as shown in Krasner. Applicant respectfully submits that such a combination is improper.

In this regard, the Office Action fails to provide a valid reason for the proposed combination. While the Office Action notes problems regarding accuracy of position information and interference as being allegedly addressed by the Krasner reference, the

Sanford reference is burdened by neither problem and, as such, the Board and the Court has explained that the skilled artisan would not be motivated to combine references to address such problems that do not exist. This improper hindsight approach is contrary to the requirements of Section 103 and relevant law. *See, e.g., KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (U.S. 2007), and as discussed at <http://www.iptoday.com/articles/2007-09-nowotarski.asp>. “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” (*In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) cited with approval in *KSR*).

The claim amendments noted above are presented to conform the scope of the claims to that which was intended in connection with the internationally-based filing. These claim amendments are not being presented herewith for reasons concerning patentability.

In view of the above, Applicant believes that each of the rejections has been overcome and the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is asked to contact the agent overseeing the application file, Peter Zawilski, of NXP Corporation at (408) 474-9063.

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